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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,340	03/29/2001	Yoriaki Matsuzaki	018793-243	8537

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/806,340

Applicant(s)

MATSUZAKI ET AL.

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6,11,16 and 17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 6 and 11 is/are allowed.
6) ☒ Claim(s) 1,2,16 and 17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/15/05.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 8/16/05.

The new grounds of rejection set forth below are necessitated by applicants amendment and thus, the following action is final.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-2 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 06-145540 taken in view of the evidence given in Ohyama et al. (U.S. 5,359,075).

The rejection is adequately set forth in paragraph 5 of the office action mailed 5/16/05 and is incorporated here by reference.

Further, it is noted that with respect to newly added claims 16-17, JP 06-45540 discloses that the quinophthalone dye is added directly to the binder and then the colorant/binder is added to aqueous vehicle. Further, the ink can contain additional additives (paragraphs 11-13). Thus, it is clear that JP 06-45540 discloses colored resin, i.e. provided by adding the colorant to the binder, aqueous dispersion, i.e. adding colorant/binder to aqueous vehicle, and aqueous ink, i.e. comprising water, colorant/binder, and additives, as required in the resent claims.

Response to Arguments

4. Applicants' arguments filed 8/16/05 have been fully considered but they are not persuasive.

Specifically, applicants argue that JP 06-145540 is not a relevant reference against the present claims given that while the present claims require quinophthalone dye with R_3 substituent of $CONR_4R_5$ where R_4 and R_5 are each linear alkyl group having 10 or more carbon atoms or branched alkyl having 8 or more carbon atoms, JP 06-145540 discloses quinophthalone dye wherein Y, which corresponds to presently claimed R_3 , is $CONR^3R^4$ where R^3 and R^4 are C_1 - C_{12} alkyl group, preferably C_1 - C_8 alkyl group.

However, applicants' attention is drawn to MPEP 2131.03. This portion of the MPEP is drawn to anticipation of ranges states that when the prior art teaches, overlaps, or is within the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation. Further, this portion of the MPEP states that "if the claims are directed to a narrow range, the reference teaches a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with "sufficient specificity" to constitute an anticipation of the claims.

However, the present claims are not drawn to a "narrow range" as set forth above. That is, the claimed alkyl group is broad as compared to the alkyl group recited by JP 06-145540. The claimed alkyl group having 10 or more carbon atoms for linear alkyl group or 8 or more carbon atoms for branched alkyl group is open-ended, and thus broader than the claimed alkyl group disclosed by JP 06-145540.

It is the examiner's position, therefore, that JP 06-145540 does disclose the claimed invention with sufficient specificity. According to MPEP 2131.03, the "test" for lack of sufficient specificity arises when the claimed range is narrow with respect to the broad reference range. That, however, is not the case here given that the claimed alkyl group is broader than the alkyl group disclosed by JP 06-145540.

Thus, it is the examiner's position that JP 06-145540 properly anticipates the present claims.

Applicants also argue that JP 06-145540 is not a relevant reference against the present claims given that there are no examples that disclose dye as presently claimed and further given that the substituent of the dye corresponding to presently claimed R_3 preferably contains C_1 - C_8 alkyl group. However, "applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others", *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, "nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims", *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). A fair reading of the reference as a whole discloses dye as presently claimed.

Applicants point to the comparative data set forth in Table 3 of the present specification to establish unexpected or surprising results over the cited prior art. It is noted that Table 3 as well as the 1.132 declaration filed 4/5/05 compares ink comprising quinophthalone dye within

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the scope of the present claims, i.e. R_3 is $CONR_4R_5$ wherein both R_4 and R_5 are C_{10} linear alkyl or C_{12} linear alkyl, with ink comprising quinophthalone dye outside the scope of the present claims, i.e. wherein R_3 is $CONR_4R_5$ wherein both R_4 and R_5 are C_8 linear alkyl or C_6 linear alkyl. It is shown that ink of the present invention is superior in terms of optical density or optical density as well as storage stability and clogging.

However, as cited in MPEP 706.02(b), it is noted that a rejection based on 35 USC 102(b), can only be overcome by (a) persuasively arguing that the claims are patentably distinguishable from the prior art, (b) amending the claims to patentably distinguish over the prior art, or (c) perfecting priority under 35 USC 119(e) or 120. As can be seen, comparative data is not sufficient to overcome an anticipatory rejection under 102(b).

Applicants also argue that the ink of JP 06-45540 is merely coated on a sheet to make thermal transfer sheet containing at least one layer of ink which is in contrast to the present claims that require aqueous ink comprising water and resin as an emulsion wherein the resin is colored by the quinophthalone dye.

However, while it is agreed that the ink of JP 06-45540 is applied to substrate and then dried to form a thermal transfer sheet, it is noted that prior to this end use, JP 06-45540 meets the requirements of the present claims. Specifically, JP 06-45540 discloses that the quinophthalone dye is added directly to the binder and then the colorant/binder is added to aqueous vehicle. Further, the ink can contain additional additives (paragraphs 11-13). Thus, it is clear that JP 06-45540 discloses colored resin, i.e. provided by adding the colorant to the binder, aqueous

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dispersion, i.e. adding colorant/binder to aqueous vehicle, and aqueous ink, i.e. comprising water, colorant/binder, and additives, as required in the present claims.

Allowable Subject Matter

5. Claims 6 and 11 are allowable over the “closest” prior art JP 06-145540 given that there is no disclosure in JP 06-145540 of pyridine azo compound as required in the claim.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

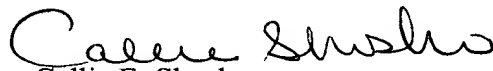
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
10/28/05